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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/720,005

11/21/2003

Matthew Howard Fronk

h-203754

3992

7590 05/01/2008  
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EXAMINER

DOVE, TRACY MAE

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

05/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/720,005	<b>Applicant(s)</b> FRONK ET AL.	
	<b>Examiner</b> TRACY DOVE	<b>Art Unit</b> 1795	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-172 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-172 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

A reissue application for U.S. Patent 6,372,376 (issued 4/16/02) was filed on 11/21/03. The declaration does not state the reissue application is a broadening reissue (see page 1 of the declaration). Applicant does not make a statement that the reissue is a broadening reissue until the second preliminary amendment filed on 10/20/04, which is more than 2 years after the patent has issued. 35 U.S.C. 251 recites “no reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.” Since the intent to broaden was not presented within two years of the patent date, a broadening reissue application cannot be granted by the Examiner.

It appears that patent claim 1 is more narrow than patent claim 8. Note for example that patent claim 1 requires the inclusion of graphite particles and specific electrically conductive particles which are not required in patent claim 8. MPEP 1412.03, section I, sets forth that a broadened reissue claim is a claim which enlarges the scope of the claims of the patent, i.e., a claim which is greater in scope than each and every claim of the original patent. Claim 1, as amended by applicant in the reissue application, does not appear to be greater in scope than each and every claim of the original patent. Thus, there does not appear to be any intent to broaden the claims within two years of the patent grant.

Claims 9-172 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. Each of claims 9-172 are broader than the claims of the patent. Note claim 80 does not require the resistivity limitation of the patent claims. A claim is broader in scope than the original claims if it contains within its scope any

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conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Claims 1-8 appear to be directed toward allowable subject matter.

#### Response to Arguments

Applicant asserts the Examiner has provided no authority for taking the position that a broadening reissue application is improper unless the Declaration explicitly states that the reissue application is a broadening reissue. However, the Examiner never stated the Declaration must explicitly state the reissue application is a broadening reissue to be proper. Examiner requests Applicant identify the section of the Office Action that assertedly takes this position. Examiner simply states the fact that the Declaration does not provide a statement that the reissue is a broadening reissue.

Applicant asserts the amendment filed on November 21, 2003 intended to broaden independent claim 1 because the addition of the word “no” changed the resistivity range of the mixture. However, the limitation “a resistivity no greater than about 50 ohm-cm” is present in patent claim 8. Claim 1, as amended on 11/21/03, is not broader than patent claim 8.

Applicant submits that patent claim 8 includes the limitation directed to the “substrate comprising a first acid-soluble metal underlying a second acid-insoluble, passivating layer susceptible to oxidation in said environment”, which is not found as a limitation in independent claim 1. Therefore, Applicant asserts that reissue claim 1 is broader than patent claim 8 in at least one respect. However, it appears that patent claim 1 is more narrow than patent claim 8. Note for example that patent claim 1 requires the inclusion of graphite particles and specific electrically conductive particles which are not required in patent claim 8. MPEP 1412.03,

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section I, sets forth that a broadened reissue claim is a claim which enlarges the scope of the claims of the patent, i.e., a claim which is greater in scope than each and every claim of the original patent. Claim 1, as amended by applicant in the reissue application, does not appear to be greater in scope than each and every claim of the original patent. Thus, there does not appear to be any intent to broaden the claims within two years of the patent grant.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is 571-272-1285. The examiner can normally be reached on Monday-Thursday (9:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 27, 2008

/Tracy Dove/

Primary Examiner, Art Unit 1795